

REMARKS

Claims 1 and 3 are pending in the present application. No new matter has been added.

Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Koda patent (Japanese Patent No. 3-150454) in view of the Matsuura reference (65662/1992). The Examiner notes that the Koda patent teaches a semiconductor sensor having a SnO_2 film, and asserts that it would have been “well within the purview of the skilled artisan” to: (1) modify the Koda sensor to include an In_2O_3 film (in view of the patent’s alleged teaching that “the SnO_2 film can be substituted with films of In_2O_3 , ZnO , etc.”) and (2) modify the In_2O_3 -containing sensor to include WO_3 film (in view of the Matsuura reference’s alleged teaching that WO_3 can be substituted with In_2O_3). The test for obviousness, however, is not merely whether those skilled in the art *could have* practiced a claimed invention but, rather, whether they would have been motivated to do so. *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (to establish a *prima facie* case of obviousness, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.”); *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with **no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed.”); MPEP §2143.01 (level of skill in the art cannot be relied upon to provide the suggestion to combine references).

Here, the Examiner has failed to identify any reason why those of ordinary skill would have been motivated to make the proposed modifications. Such motivation certainly is not provided by the cited references. The Examiner, for example, is mistaken with respect to his suggestion that the Matsuura reference discloses the use of In_2O_3 , SnO_2 , and WO_3 as interchangeable compounds. Indeed, the reference specifically **contrasts** WO_3 with In_2O_3 and SnO_2 by identifying the latter compounds as having been used for “comparative” examples. (Matsuura reference at p. 5). Still further, the Matsuura reference teaches sensors that operate at a single temperature, 300° C. (*id.*), and thus is plainly inconsistent with the claimed operation at a first temperature and a second lower operating temperature.

DOCKET NO.: CACS-0017
Application No.: 09/786,176
Office Action Dated: July 13, 2004


PATENT

There is simply no reason to believe that those of ordinary skill seeking to develop gas sensing methods would have been motivated to combine the teachings of the Koda and the Matsuura reference, much less do so in a way that would have produced one of Applicants' claimed methods. Accordingly, the rejection of claims 1 and 3 under 35 U.S.C. § 103 is improper and should be withdrawn.

Conclusion

In view of the foregoing, Applicants submit that the present claims meet all the requirements for patentability. Accordingly, an indication of allowability and a notice of allowance is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at (215) 557-5996 if there are any questions concerning Applicants' claimed inventions.

Date: November 15, 2004


Hallum O. Bailey
Registration No. 56,093

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439